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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------------|------------------|
| 10/772,190 | 02/04/2004 | David C. Windorski | 59529US002 | 4676 |
| 32692 | 7590 | 08/09/2006 | | |
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| | | | EXAMINER DESAI, ANISH P | |
| | | | ART UNIT 1771 | PAPER NUMBER |

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/772,190 | Applicant(s) WINDORSKI, DAVID C. | |
| | Examiner Anish Desai | Art Unit 1771 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-19 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/23/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The applicant's arguments in response to the Office action dated 02/23/06 have been fully considered.
2. Claims 1-20 are pending. Claims 1-6 are withdrawn.
3. All of the art rejections are maintained.
4. Claim objections are withdrawn in view of the present amendments and response (see page 3 of 05/23/06 amendments).

Information Disclosure Statement

5. The information disclosure statement filed 03/23/06 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited **foreign patent document**; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Allowable Subject Matter

Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The claim 20 is indicated as allowable over all of the references of record. The most pertinent is US 3,517,106 to Chase. Chase does not teach or suggest a second cover layer having a pressure sensitive adhesive layer wherein the cover layer is adhered to the back side of the paper layer to cover the second paperless zone in an alignment where a bottom edge of the second cover layer extends across the gap of the second paperless zone as claimed in claim 20. Further

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Chase does not teach or suggest the adhesive on the inner face of the second cover layer is exposed across the second paperless zone on the front side of the paper layer as claimed in the claim 20. One skilled in the art would not have been motivated to add an additional adhesive layer and cover layer on top of the release layer because to do so would destroy its intended utility.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 7-11,13,15,18, and 19 are rejected under 35 U.S.C. 102(b) as anticipated by Chase (US 3,517,106) substantially as set forth in the 02/23/06 Office Action.

Chase teaches methods and materials for mounting illustrations, clippings, pictures and the like in accurate position on mounting boards, picture-album pages, and like supports (Column 1, lines 13-16). With respect to claim 7, Chase teaches a thin paper web coated with pressure sensitive adhesive layer on both surfaces of the paper web wherein the pressure sensitive adhesive layer is covered with a paper release sheet on both sides of the pressure sensitive adhesive layers (Column 1, lines 16-17, Column 4, lines 71-75, Column 5, lines 1-2). Further, Figure 1 and Figure 2 of Chase shows a paper web W coated on both sides with the pressure sensitive adhesive A and a release sheet that is made of easily separable sections IR and ER. The removal of one section of the release sheet as shown in Figure 1 exposes the pressure sensitive

adhesive layer A as indicated by CA. The paper release sheet as shown in Figures 1 and 2 of Chase reads on the claimed paper layer wherein a portion of the paper layer having an upper edge with a portion of the paper layer being removed to define a paperless zone which includes a gap across the upper edge as claimed in the claim 7. Further, the pressure sensitive adhesive coated paper web W (Figures 1 and 2) of Chase reads on the cover layer having pressure sensitive adhesive disposed on its inner face where the cover layer adhered thereby to the front side of the paper layer to cover the paperless zone in an alignment where a top edge of the cover layer extends across the gap of the paperless zone and the adhesive on the inner face of the cover layer is exposed across the paperless zone on the back side of the paper layer. Note that the paper based release sheet inherently has a writable front side and an opposite side.

With respect to claim 8, Chase at Column 1 lines 35-46 and Figure 10 teaches that if it is desired to secure a picture to a support such as an album page, a mount with adhesive on both surfaces is used, and after the picture is adhered to the mount a section of the release sheet on the other side of the mount is removed and the composite picture and mount is arranged on the support so only the remainder of the release sheet touches the mount and the composite picture and mount is accurately located and held in position while the exposed adhesive is pressed into adhering contact with the support thereby fixing the position of the picture on the support. Further note that the pressure sensitive adhesive coated web W is thin and made of paper

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(Column 4, line 71) thus the web W is inherently flexible. The examiner is equating the album page of Chase as the claimed surface as claimed in the claim 8.

With respect to claims 9-11, although Chase does not explicitly teach the outer face of cover layer is a writeable surface, the outer face of the cover layer bears indicia, and the indicia includes color. However, it is the examiner's position that the paper web W of Chase is writeable and is capable of receiving colored indicia because the paper web is made of a paper.

With respect to claim 13, Chase teaches that the release sheet has sufficient thickness so that when a center section of the release sheet is removed (Figure 1) and one or more sections can be removed and the picture to be mounted can be moved about on the remainder of the release sheet without adhesively contacting the exposed adhesive until the picture is accurately positioned on the mount, at which time the picture is pressed into contact with the exposed adhesive (Column 1, lines 24-32).

With respect to claim 15, as shown in Figure 1, the opening created due to the partial removal of the release sheet is centered across the upper edge of the release sheet.

With respect to claim 18, as shown in the Figures 1 and 2 of Chase, the upper edge of the release sheet and the top edge of the adhesive coated paper web W are co-linear.

With respect to claim 19, the release sheet of Chase has number of easily separable sections (Column 5, lines 19-20 and Figure 1), thus the removal of the

separable sections will create plurality of exposed zones with the exposed adhesive as claimed in the claim 19.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chase (US 3,517,106) in view of Nygard et al. (US 5,458,938) substantially as set forth in 02/23/06 Office Action.

The invention of Chase as applied to claim 7 is previously disclosed. Chase is silent as to teaching of repositionable pressure sensitive adhesive. However, Nygard teaches a mounting laminate to which documents (e.g. a piece of paper) can be attached either temporarily or permanently (Column 1, lines 7-9). Further Nygard teaches that a variety of known pressure sensitive adhesives can be used for the interior adhesive layer of the novel mounting laminate and to permit mounted items to be removed without damage, the pressure sensitive adhesive should be repositionable. The repositionable pressure sensitive adhesive affords the economy and reusability of the novel mounting laminate (Column 5, lines 19-26). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the repositionable pressure sensitive adhesive in the invention of Chase, motivated by the

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desire to provide a reusable pressure sensitive adhesive mount to which a picture can be attached.

8. Claims 14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chase (US 3,517,106) substantially as set forth in 02/23/06 Office Action.

The invention of Chase as applied to the claims 7 and 13 is previously disclosed. With respect to claim 14, although Chase does not explicitly teach a plurality of index card assemblies aligned in a stacked orientation fails to adhere together, absent the application of pressure to the outer faces of their respective cover layers. It is the examiner's position that since Chase broadly teaches that the release sheet has sufficient thickness and the adhesively coated paper web is thin, thus it is obvious that the picture placed on the release sheet with a portion of the release sheet being removed would not adhere to the exposed adhesive of Chase until pressure is applied to the adhesively coated web.

With respect to claim 16 although Chase does not explicitly teach that the paperless zone has curved edges, it is the examiner's position that since there is no evidence on the record that indicates that the particular geometry (e.g. curved edges) of the paperless zone is significant or is anything more than one of the numerous geometries that is obvious to person having ordinary skill in the art, therefore the paperless zone having curved edges does not render the claim patentable over the prior art. Thus, it would have been obvious to choose the shape of the paperless zone in the

form of curved edges to accommodate a picture with the curved edges in the invention of Chase.

With respect to claim 17, Chase is silent as to teaching of V-shaped paperless zone. However, it is the examiner's position that since there is no evidence on the record that indicates that the particular shape of the paperless zone is significant or is anything more than one of numerous shapes a person of ordinary skill in the art would find obvious for the purpose of providing V-shaped paperless zone, therefore, the V-shaped paperless zone of the instantly claimed invention would not render the claim patentable over the prior art.

Response to Arguments

9. Applicant's arguments filed 05/23/06 have been fully considered but they are not persuasive.

The art rejections of Chase '106 are maintained for the following reasons. The applicant argues that Chase '106 does not anticipate the applicant's invention. The applicant argues that it is not possible for the front side of the Chase's release liner to be writable because the front side of the release liner is covered by the adhesive A. The examiner respectfully disagrees. While it is true that the one side of the release liner of Chase '106 covers the adhesive layer A, the "writable front side" of the applicant's "paper layer" also covers the adhesive layer that is present on the underlying cover layer. Therefore, it is not clear that why would a release liner of the Chase reference is not "writable" whereas the applicant's paper layer is "writable". The obvious differences between the claim and the reference of Chase '106 are not present

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in the claim. Additionally the applicant argues that once the users peels away a section of the release liner that section is no longer part of the construction of Chase's mount, thus even if the user were to write on the first surface of the removed section CR, it is no longer part of the mount assembly. The examiner respectfully disagrees. The arguments is irrelevant because even if the user were to remove a part of the release liner (e.g. CR), there are other sections of the release liners that are present on the adhesive layer of Chase '106 (Figure 1). Additionally, the claim language "a paper layer having a writeable front side and an opposite back side, the paper layer having an upper edge...gap across the upper edge" does not exclude that the paper layer cannot be removed. Accordingly, the art rejections are sustained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**HAIVO
PRIMARY EXAMINER**